



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCE

Applicant : Eskuchen et al.
Appl. No. : 09/402,232
Filed : 09/30/99
Title : THE PROCESS FOR PREPARING ALKYL AND/OR ALKEN
OLIGOGLYCOSIDES

Grp./A.U. : 1623
Examiner : L. Maier

Docket No. : H 2849 PCT/US

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Date

Marlene Capreri
Signature of certifier

Marlene Capreri
Typed or printed name of certifier

APPEAL BRIEF TRANSMITTAL

Commissioner for Patents
Washington, DC 20231

Sir:

Appellants' brief, in triplicate, is transmitted herewith in accordance with 37 CFR 1.192.

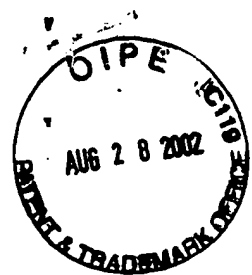
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Respectfully submitted,

Cognis Corporation
2500 Renaissance Blvd., St. 200
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Steven J. Trzaska
(Reg. No. 36,296)
Attorney for Applicant(s)
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Washington, DC 20231

BRIEF ON APPEAL UNDER 37 C.F.R. 1.192

Sir:

REAL PARTY IN INTEREST

The real party in interest is Cognis Deutschland GmbH & Co. KG,
Henkelstrasse 67, 40589 Duesseldorf, Germany.

RELATED APPEALS AND INTERFERENCES

None.

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STATUS OF CLAIMS

Claims 25-37 are the subject of this appeal.

STATUS OF AMENDMENTS

No amendments were made after final rejection.

SUMMARY OF THE INVENTION

Briefly stated, the present invention is directed to a process for making alkyl and/or alkenyl oligoglycoside by combining a water-containing glucose sirup with an excess of fatty alcohol to form a suspension, adding an acid catalyst to the suspension to form a reaction mixture, and then acetalizing the reaction mixture to form the alkyl and/or alkenyl oligoglycoside. See page 2, lines 7 to 15.

ISSUES

Whether claims 25-33 and 37 are obvious under 35 U.S.C. § 103(a) over McCurry et al, US 4,950,743.

Whether claims 25 and 34-36 are obvious under 35 U.S.C. § 103(a) over McCurry et al, US 4,950,743 in view of Grutzke et al, US 5,648,475.

GROUPING OF THE CLAIMS

The claims stand and fall together.

ARGUMENT

McCurry '743 fails to render the claimed invention obvious on the grounds that it fails to teach or suggest all of the claim limitations.

Initially, Appellant would like to note that it is extremely well settled that in order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there

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must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure [underline emphases added]. See, *Manual of Patent Examining Procedure*, Rev. 3, July 1997, § 2142, pages 2100-108.

Appellant respectfully submits that the '743 reference fails to render the claimed invention prima facie obvious on the grounds that it **admittedly** fails to teach or suggest **many** of the claimed elements of the present invention. Specifically, the '743 reference admittedly fails to teach or suggest: (1) the use of the claimed glucose sirup; (2) the use of the claimed preheated fatty alcohol used to form the claimed suspension; (3) the addition of acid catalyst to the glucose sirup/fatty alcohol suspension prior to drying; (4) the claimed acetalization temperature gradient; and (5) the claimed ratios of reactants. In response to this admitted lack of teaching or suggestion relating to the above-noted claimed elements of the present invention, the Examiner has maintained the position that all of said claim limitations, which are admittedly neither taught nor suggested by the '743 reference, are nevertheless obvious to those of ordinary skill in the art. The premises upon which the Examiner's conclusion of obviousness are based include, "convenience" and "obvious optimization". These premises, however, are neither taught nor suggested anywhere within the four corners of the '743 reference, nor are they based on sound technical reasoning. Rather, they are based merely on the Examiner's unsupported speculation and assumption.

As a result, Appellant respectfully submits that it is extremely well settled that, "The Patent Office ... may not, because it may **doubt** that the invention is patentable, resort to speculation, unfounded assumptions or hindsight to supply deficiencies in its factual basis."

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See, In re Warner, 154 USPQ 173, 178 (CCPA 1967). The ultimate legal conclusion of obviousness must be based on facts or records, not on the Examiner's unsupported allegation that a particular modification is known and therefore obvious. Subjective opinions are of little weight in determining obviousness. See, In re Wagner et al., 152 USPQ 552 (CCPA 1967). Consequently, since the '743 reference admittedly fails to teach or suggest all of the claimed limitations of the present invention, it cannot serve to render said invention prima facie obvious. See, MPEP 2142, supra.

Finally, Appellant would also like to note that it is well settled in the law that the mere allegation that the differences between the claimed subject matter and the prior art are obvious does not create a presumption of unpatentability which forces an Applicant to prove conclusively that the Patent Office is wrong. See, In re Soli, 137 USPQ 797 (CCPA 1963). Consequently, since nothing contained in the paragraph bridging pages 3 and 4 of the previous Office Action (Paper No. 16) qualifies as facts and/or technical reasoning sufficient to satisfy the Examiner's burden of proof in establishing the obviousness of the present invention in view of the teachings of the '743 reference, Appellant respectfully submits that the claimed invention is therefore patentable over its teachings.

Neither the McCurry '743 nor the Grutzke '475 references, alone or in combination, contain the requisite teaching or suggestion to render claims 25 and 34-36 of the present invention prima facie obvious.

The shortcomings associated with the teaching of the '743 reference are as outlined above, and **admitted to** by the Examiner. The '475 reference is cited merely for its alleged teaching concerning the use of a cascade of reactors. However, it is respectfully submitted that regardless of whether the teaching of the '475 reference relating to the use of a cascade of reactors is obvious or not, since neither reference, **alone or in combination**, teaches or suggests **all of the claim limitations of the present invention**, a prima facie case of obviousness would nevertheless fail to be established against the claimed

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invention. See, *MPEP*, section 2142, pages 2100-108.

SUMMARY

McCurry '743 fails to teach or suggest all of the claim limitations and, as a result, should not serve to render the claimed invention prima facie obvious.

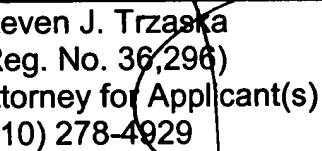
Both McCurry '743 and Grutzke '475 fail to teach or suggest all of the claim limitations of the present invention and, as a result, should not serve to render the claimed invention prima facie obvious.

It is requested for the reasons given above, that the Board find for Appellant on all of the issues, and reverse the Examiner's Final Rejections.

Respectfully submitted,

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APPENDIX

CLAIMS ON APPEAL

25. (First amended) A process for making alkyl and/or alkenyl oligoglycosides comprising:

- (a) providing a glucose sirup;
- (b) providing a fatty alcohol;
- (c) combining the glucose sirup with the fatty alcohol in order to form a glucose sirup/fatty alcohol suspension;
- (d) providing an acidic catalyst;
- (e) drying the glucose sirup/fatty alcohol suspension at a temperature gradient of from about 70 to 120°C to form a dried glucose sirup/fatty alcohol suspension;
- (f) adding the acidic catalyst to the dried glucose sirup/fatty alcohol suspension; and
- (g) acetalizing the dried glucose sirup/fatty alcohol suspension containing the acidic catalyst to form the alkyl and/or alkenyl oligoglycosides.

26. (new) The process of claim 25 wherein the glucose sirup has a solids content of from 50 to 85% by weight, based on the weight of the glucose sirup.

27. (new) The process of claim 25 wherein the glucose sirup has a monomeric glucose content of from 80 to 99.9% by weight, based on the weight of the glucose sirup.

28. (new) The process of claim 25 wherein the glucose sirup of (a) is in supercooled melt form.

29. (new) The process of claim 25 wherein the fatty alcohol of (b) is preheated to a temperature of from 25 to 40°C.

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30. (new) The process of claim 25 wherein the fatty alcohol corresponds to formula (I):



wherein R¹ is an aliphatic, linear or branched hydrocarbon radical having from 6 to 22 carbon atoms, and up to 3 double bonds.

31. (new) The process of claim 25 wherein the glucose sirup and fatty alcohol are combined in a molar ratio of from 1:1 to 1:10.

32. (new) The process of claim 25 wherein the catalyst is added to the glucose sirup/fatty alcohol suspension in an amount of from 0.1 to 5% by weight, based on the weight of the suspension.

33. (new) The process of claim 25 wherein the process is carried out discontinuously in a stirred tank reactor.

34. (new) The process of claim 25 wherein the process is carried out in a cascade of from 3 to 6 stirred reactors.

35. (new) The process of claim 34 wherein the glucose sirup/fatty alcohol suspension is dried in the first reactor.

36. (new) The process of claim 34 wherein the cascade of stirred reactors has a pressure gradient of from 20 to 50 mbar.

37. (new) The process of claim 25 wherein acetalization is carried out under reduced pressure.